Remarks

In this response, Applicants have cancelled Claims 27-30, 33, 35, and 42. Applicants have presented arguments to overcome the Examiner's rejections. Claim 34 has been amended to make the claim more clear and to remove the extraneous period following the pH of "8.8". Claim 36 has been amended to make the claim more clear.

Claim Objection

Claims 28, 34-35, 37, and 42 are objected to because of the term "about." As previously stated this is inconsistent with the law and the practice of the Patent Office. Claims 28, 35, and 42 recite a pH range from "about 8.2 to about 8.5" and are dependent on a pH range from "about 8.2 to about 8.8." Thus, this is a narrowing range and thus is a further limitation on the independent claim from which it depends. Further, the MPEP states that "about" is definite unless there is close prior art. (MPEP § 2173.05(b)(A)). (*See also Ex parte Eastwood,* 163 USPQ 303 (Bd. App. 1968) and *W.L. Gore v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983)). Here there is no prior art that would render the term "about" indefinite. However, to further prosecution, Applicants have cancelled claims 28, 35, and 42 without prejudice to pursue in a continuation application.

REJECTION UNDER 35 U.S.C. § 112 FIRST PARAGRAPH

Claims 27-30, and 33 stand rejected under 35 U.S.C. § 112, first paragraph as containing subject matter that is not enabled. Applicants maintain the position that the Examiner has not met her burden to establish a reasonable basis to question the enablement provided for the claimed invention. See *In re Wright,* 999 F.2d 1557, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993). See also MPEP § 2164.04. In examining a patent application, the PTO is required to assume that the specification complies with the enablement provision of § 112 unless it has acceptable evidence or reasoning to suggest otherwise. *In re Marzocchi,* 439 F.2d 220, 223, 169 USPQ 367, 369-370 (C.C.P.A. 1971). However, to further prosecution, Applicants have cancelled claims 27-30, and 33 without prejudice to pursue in a continuation application.

REJECTION UNDER 35 U.S.C. § 112 SECOND PARAGRAPH

Claims 27-30, and 33 stand rejected under 35 U.S.C. § 112, second paragraph as being ambiguous. Applicants maintain the position that the claims are definite and particularly point out and distinctly claim the subject matter being sought. However, to

further prosecution, Applicants have cancelled claims 27-30, and 33 without prejudice to pursue in a continuation application.

REJECTION UNDER 35 U.S.C. § 102(e)/ § 103

Applicants respectfully maintain the position that the Hoffmann reference (U.S. Patent No. 6,358,924) is not a 103 reference. Section 103 (c) prevents a potential 102 (e) reference from being prior art for 103 purposes if the prior art subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. 35 U.S.C. 103(c)(1).

In this case the prior art subject matter and the claimed invention were subject to an obligation of assignment to Eli Lilly and Company at the time the invention was made. Applicants therefore, request reconsideration and withdrawal of this rejection.

SUMMARY AND CONCLUSION

Applicants respectfully assert that the application is now in condition for allowance. Applicants understand that this response is being submitted after Final, however, this case is extremely important to Eli Lilly and Company and if the Examiner does not favorably consider Applicants comments and arguments, Applicants would appreciate the opportunity to discuss this case face to face with the Examiner in a formal interview under 37 C.F.R. §1.333.

If, for any reason, the Examiner feels that a telephone conversation would be helpful in expediting the prosecution of this case, the Examiner is urged to call me.

Respectfully submitted,

Gregory A. Cox
Attorney for Applicants
Registration No. 47,504
Phone: 317-277-2620

Eli Lilly and Company
Patent Division/GAC
P.O. Box 6288
Indianapolis, Indiana 46206-6288

Jan 31, 2005